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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,195	05/23/2000	Kia Silverbrook	NPA002US	9147
24011	7590	02/24/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/575,195	SILVERBROOK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Calvin L. Hewitt II	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 January 2006.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-26 and 28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

***Status of Claims***

1. Claims 1-26 and 28 have been examined.

***Response to Amendments/Arguments***

2. Applicant has amended the claims to recite a pen “generating indicating data using the coded data printed on the form”, however, this process is clearly taught by the prior art.

To one of ordinary skill, the prior art teaches coded data printed on a form, as Hamrick discloses printing data stored in a computer memory (column/line 5/66-6/3). Data stored in a computer is “in code”, hence when it is printed the data is “coded”, or data that had previously been “in code”. Hamrick teaches filling out the printed form using “check marks” for example (column 5, lines 35-38; column 6, lines 8-10). On the other hand, Henderson recites embedding coded data into a document (column 17, lines 42-54). Henderson teaches making changes (column 4, lines 41-59) to an electronic document by applying said changes to a hardcopy version of said document (figure 1). Thus, a user in the combined teaching, when placing an order, applies a pen to the printed form (i.e. coded data) to “fill-in” or “mark” the form (column/line 5/66-6/3; column 19, lines 35-47). Further, this [pen] application process generates data regarding (i.e.

"relates to") the identity of the form ('740, column 17, lines 42-54; column 18, lines 8-16; '998, column 5, lines 42-64). The process also generates data regarding (i.e. "relates to") the location of the pen relative to the form such as data indicating where the pen is on the printed form to enable the computer to make the corresponding edits on the electronic document ('740, column 19, lines 35-47).

Applicant is of the opinion that the claims unambiguously recite "by reading [this] coded data, the pen can determine its location relative to the form" (Response, 1-12-06, page 8, "Claim Rejections-35 USC section 103, third full paragraph) however, the Examiner cannot find this limitation in the claims. To the contrary, in order read on Applicant's claims all that is needed from a prior art pen is that it generates indicating data using the coded data printed on the form where the indicating data is regarding the location of the pen relative to the form. When describing the claimed method, Applicant uses broad language ("indicating", "regarding", "coded data"), and it has been held that during patent examination pending claims must be interpreted as broadly as their terms reasonably allow (*In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Pearson*, 181 USPQ 641 (CCPA 1974)), therefore, the combined prior art continues to read on Applicant's claims.

The Examiner can be contacted by e-mail ([calvin.hewitt@uspto.gov](mailto:calvin.hewitt@uspto.gov)) or Applicant can leave a message at the Examiner's work phone (571-272-6709) regarding sections 8.4.3 and 8.4.4 of Applicant's Specification.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-22, 24, 25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrick, U.S. Patent No. 5,451,998 in view of Henderson et al., U.S. Patent No. 5,737,740.

As per claims 1-8, 10, 12, 13, 18, 20-22, and 28, Hamrick teaches a method of purchasing using a [multi-page] form (figure 2; column 2, lines 2-15; column 5, lines 35-40 and 64-66) comprising: downloading and printing the form (on a surface defining means) (abstract; column 5, lines 30-38; column 6, lines 1-3) wherein the form comprises coded data indicative of the identity of the form and a plurality of map locations on the form (column 5, lines 28-40), and submitting a purchase order by identifying a purchase transaction using the printed form (abstract; column/line 5/28-6/13). However, Hamrick does not

specifically recite using an optically imaging pen to interact with the form.

Henderson et al. teach interacting with a form using an optical imaging pen (abstract; column 5, lines 52-62; column 11, lines 5-55). Specifically, Henderson et al. teach:

- a computer system allocating and recording a form identity, and associating the form identity with a map of the form in the computer system, wherein the form includes coded data and a plurality of map locations (column 4, lines 8-24; column 7, lines 38-40)
- interacting with a printed version of the form using an optical imaging pen (by placing the pen in an operative position relative to the form) (abstract; column 11, lines 5-55)
- generating indicating data by the pen using the coded data, the indicating data comprising data regarding the identity of the form and data regarding the location of the pen relative to the form (abstract; column 11, lines 5-55)
- receiving in the computer system the indicating data from the pen (abstract; figure 1; column 4, lines 28-35; column 11, lines 5-55; column 15, lines 10-29; column 17, lines 1-30)

- identifying parameters in the computer system using the indicating data and the map of the form (e.g. at least one zone) (abstract; column 4, lines 28-35; column 11, lines 5-55; column 15, lines 10-29)
- receiving data in the computer system regarding the movement of the pen (abstract; figure 1; column 15, lines 10-29; column 17, lines 1-30)
- converting handwritten text to computer text (abstract; figure 1; column 5, lines 52-62)

Henderson et al. also teach monitoring the pen using a pen identity in order to associate the pen's movements with edits to be made to the electronic file (abstract; figure 1; column 15, lines 10-29; column 17, lines 1-30). Regarding, the relationship of the pen to the potential user, it would have been obvious to name the file. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hamrick and Henderson et al. in order to allow users to enter data into an electronic form, such as an order form ('998, column/line 5/35-6/15), in a more familiar and easier to use manner ('740, column 4, lines 36-41).

As per claims 9, 11, 14-17, 19, 24, 25, Hamrick disclose order forms for purchasing goods and services (abstract; column/line 5/28-6/13). A well-known method for making purchases using electronic order forms is to obtain more

information on the goods to be ordered and to include the number of goods in the order and a shipping address, as well as retrievable purchase receipts. Similarly, order forms that comprise credit card info and user authorization signatures are also well known. Hamrick also discloses transmitting the form electronically (abstract). Therefore, it would have been obvious to one of ordinary skill to use well-known technologies such as pointcast or multicast in order for transmitting the form. Further, it has been held that an obvious modification to the order form of Hamrick would be to add designs or images that relate to the shopping experience (e.g. horn of plenty, shopping cart, carton of milk, etc.) (*In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947)).

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrick, U.S. Patent No. 5,451,998 and Henderson et al., U.S. Patent No. 5,737,740 as applied to claim 22 above and in further view of Dougherty et al., U.S. Patent No. 6,076,734.

As per claim 23, Hamrick teaches printing a form with coded information and using the form to purchase goods and services (abstract; column 2, lines 2-15; column 5, lines 36-38 and 64-66). Henderson et al. teach interacting with the form using an optically imaging pen (abstract). However, neither Hamrick nor Henderson et al. disclose invisible coded data. Dougherty et al. teach a method for ordering goods and services by reading invisible coded data on a form using

an optically imaging pen (column 5, lines 29-62; column 8, lines 15-24).

Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hamrick, Henderson et al. and Dougherty et al. in order to allow users to more efficiently order data by accessing directly the seller's electronic address ('734, column 3, lines 3-8, column 8, lines 15-24; '998, column 2, lines 2-15, column 5, lines 36-38 and 64-66) using the printed form ('998, column 2, lines 2-15, column 5, lines 36-38 and 64-66; '740, abstract).

6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrick, U.S. Patent No. 5,451,998 and Henderson et al., U.S. Patent No. 5,737,740 as applied to claim 1 above and in further view of Ito et al., U.S. Patent No. 5,453,762.

As per claim 26, Hamrick teaches printing a form with coded information and using the form to purchase goods and services (abstract; column 2, lines 2-15; column 5, lines 36-38 and 64-66). Henderson et al. teach interacting with the form using an optically imaging pen (abstract; column 5, lines 32-62) such as a corded pen (column 5, lines 45-51). However, neither Hamrick nor Henderson et al. disclose a unique pen identity. Ito et al. teach a pen with unique pen identity

and identifies a user using said pen (figures 3, 9, and 11; column 6, lines 65-67; column 7, lines 38-47). Therefore, it would have been obvious to modify the combined teachings of Hamrick and Henderson et al. with Ito et al. in order to more accurately translate the movements of the pen ('740, abstract; '762, column 1, lines 10-21, column 2, lines 45-56, column/line 11/55-12/9) into document, such as order forms, edits.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 3600  
Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")



A handwritten signature in black ink, appearing to read "Calvin Loyd Hewitt II". The signature is fluid and cursive, with a large oval flourish on the left side.

February 21, 2006